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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,645	04/04/2001	William Jackson Bushnell	LUC-299/Bushnell 20-1	5465

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EXAMINER
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JUNTIMA, NITTAYA

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/825,645	Applicant(s) BUSHNELL ET AL. 	
	Examiner Nittaya Juntima	Art Unit 2663	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6-7, 9, 11-12, 14, 16-17, 19, 21-22, 24, 26-27, and 29 is/are rejected.
- 7) ☒ Claim(s) 3, 5, 8, 10, 13, 15, 18, 20, 23, 25 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/4/01, 8/29/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 4/4/01 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the references cited on page 1 of 2 are not found in the case. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Drawings***

2. The drawings are objected to because reference numbers in Fig. 1 should be descriptive text labeled. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claims 9, 11, 19, and 29 are objected to because of the following informalities:

- in claim 9, ll 2, "are" should be changed to "is;"
- in claim 11, ll 1, "steps" should be changed to "step;"
- in claim 19, ll 5, "are" should be changed to "is;"
- in claim 29, ll 6, "are" should be changed to "is."

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4, 6-7, 9, 11-12, 14, 16-17, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Greenberg (USPN 6,791,974 B1).

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Per claim 1, as shown in Fig. 1, Greenberg teaches a system, comprising:

A phone (customer's terminal device T1) that comprises a connector component (the web site of web server 100A) that is operationally connectable through a packet network (Internet) to any selected one or more of a plurality of switch components (switches that must be residing in the inter exchange center IXC 104 and LEC2 for connecting T1 to a telephone station set SS1). See col. 3, ll 66-col. 4, ll 1-35 and col. 9, ll 12-47. See also col. 6, ll 31-65.

Wherein the any selected one or more of the plurality of switch components serve to provide one or more of originating (calling) and terminating (disconnecting) telecommunication service to the phone (col. 9, ll 12-47).

Per claim 2, Greenberg also teaches that the connector component (the web site of web server 100A, Fig. 1) employs an explicit selection of a particular switch component of the plurality of switch components to operationally connect the phone through the packet network to the particular switch component, wherein a user of the phone inputs the explicit selection (the calling party locate at T1 enters a destination 10-digit telephone number, col. 9, ll 12-47).

Per claim 4, Greenberg further teaches that the plurality of switch components comprises a first switch component (a switch that must reside in IXC 104 for connecting T1 to SS1) and a second switch component (a switch that must reside in LEC2 for connecting T1 to SS1); wherein the phone (T1) comprises a connector component (the web site of web server 100A) that is operationally connectable to the first switch component through the packet network and operationally connectable to the second switch component through the packet network. See Fig. 1 and col. 9, ll 12-47.

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Per claim 6, Greenberg teaches that the phone (T1) comprises a connector component (the web site of web server 100A) that is operationally connectable through the packet network (Internet) to the any selected one or more of the plurality of switch components (switches that must be residing in the inter exchange center IXC 104 and LEC2 for connecting T1 to a telephone station set SS1) through a respective one voice over Internet protocol gateway (a PSTN gateway 100B). See Fig. 1 and col. 9, ll 12-47.

Per claim 7, Greenberg teaches that the phone (T1) is registrable with any selected one (a PSTN gateway 100B) of a plurality of voice over Internet protocol gateways (the Internet of Fig. 1 must have a plurality of VoIP gateways). See Fig. 1 and col. 7, ll 5-32.

Per claim 9, Greenberg further teaches that the phone is registrable with any selected one (a PSTN gateway 100B) of a plurality of voice over Internet protocol gateways that is owned and/or operated by a plurality of service providers (the Internet of Fig. 1 must have many VoIP gateways that are owned/operated by many service providers). See Fig. 1 and col. 7, ll 5-32.

Claims 11-12, 14, 16-17, and 19 are method claims corresponding to system claims 1-2, 4, 6-7, and 9, respectively, and therefore are rejected under the same reason set forth in the rejection of claims 1-2, 4, 6-7, and 9, respectively.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 21-22, 24, 26-27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg (USPN 6,791,974 B1).

Claims 21-22, 24, 26-27, and 29 are article claims corresponding to method claims 11-12, 14, 16-17, and 19, respectively, and therefore are rejected under the same reason set forth in the rejection of claims 21-22, 24, 26-27, and 29, respectively, with an exception that Greenberg does not teach a computer-readable signal-bearing medium as recited in independent claim 21.

However, it would have been obvious to one skilled in the art at the time the invention was made to include a computer-readable signal-bearing medium as recited in claim 21 to automatically and systematically execute the claimed steps.

***Allowable Subject Matter***

8. Claims 3, 5, 8, 10, 13, 15, 18, 20, 23, 25, 28, and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nittaya Juntima whose telephone number is 571-272-3120. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

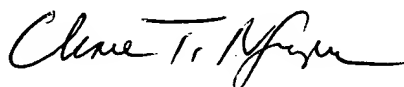
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nittaya Juntima  
December 1, 2004

*NJ*



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SUPERVISORY PATENT EXAMINER  
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